REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the thorough review of the present application. Based upon the amendments and the following remarks, Applicants respectfully request reconsideration of the present application and allowance of the pending claims.

The Present Invention

The present invention a method of preventing reduction of sales amount of records due to a digital music file illegally distributed through the communication network, by distributing the digital music files with low or damaged sound quality on the network in place of restraining an illegal reproduction and distribution, and using the distributed music files only for "pre-listening".

35 U.S.C. § 101 Rejection

Claim 1 stands rejected under 35 U.S.C. § 101 because, according to the Examiner, the claim is directed to non-statutory subject matter. According to Office Action, "the claim language is merely non-functional descriptive material disembodied from technological arts. For example, the "communication network" interpreted broadly reads on the US Postal system, i.e., letter mail communication of post offices.

Claim 1 has been amended to further define the term "communication network" as a "computer communication network". The specification further defines a computer communication network as including the Internet. However, since the applicant believes that music files can be communicated through other computer networks, other than the Internet, the applicant believes that the amended language sufficiently claims the desired method. Likewise, independent Claim 6 has been amended to further define the term "communication network" as a "computer communication network".

Applicant is unaware of other language within Claim 1 that would lend itself to non-statutory subject matter or language that is merely non-functional descriptive material disembodied from the technological art. If the Examiner believes that other language in Claim 1 does not meet the criteria of 35 U.S.C., the applicant kindly asks that the Examiner provide direct references to such language and the applicant will kindly make every effort possible to correct such language.

35 U.S.C. § 103 (a) Rejections

Claims 1-10 stand rejected as being obvious over United States Patent No. 6,591,365, issued to Cookson (the '365 Cookson patent), in view of United States Patent No. 6,650,761, issued to Rodriguez (the '761 Rodriguez patent).

According to the Office Action, the '365 Cookson patent teaches all of the elements of independent Claim 1, specifically:

> A method of preventing reduction of sales amount of records due to a digital music file illegally distributed through a computer communication network...producing an advertising digital music file.... of a record of a cooperating record corporation... [and] distributing the advertising digital music file through the computer communication network.

However, according the Examiner the '365 Cookson patent lacks a teaching of producing an advertising digital music file "by deteriorating or damaging a sound quality of an original music file.."

The Examiner relies on the '761 Rodriguez patent for a teaching of producing an advertising digital music file "by deteriorating or damaging a sound quality of an original music file.."

Additionally, according to the Examiner it would have obvious to combine the disclosure of Rodriguez with the teaching of Cookson because such combination would have "provided "a copy-protection scheme....[used in conjunction with] laws...such as this that exist in the U.S...that would make it a crime to foil a player designed to protect against play of pirated music..." (Cookson, Column 2, lines 1-10).

The '365 Cookson Patent and the '761 Rodriguez Patent Do Not Teach Producing an *Advertising* Digital Music File

The '365 Cookson patent teaches a method for inserting two watermarks in a digital music file; a robust mark that represents the permissible use to be made of the music and a weak watermark that is destroyed if the music is compresses and then examining the file to determine the presence of the marks in order to determine the allowed use of the music. As such, the '365 Cookson patent provides producing fully functional and, in fact, "marketable" digital music files. The '365 Cookson patent provides no teaching of the production of an advertising digital music file.

The '761 Rodriguez patent teaches watermarked business cards that may contain audio watermarks having technical playback parameters. As such, the '761 patent provides no teaching of the production of an advertising digital music file.

Claim 1 of the present invention specifically states that an advertising digital music file be created. The advertising music file is defined in the specification and in the claim as being a damaged or deteriorated music file. Thus, an advertising digital music file is considerably less, in terms of quality, than the fully functional and marketable digital music files that are taught by the '365 Cookson patent.

For this reason, applicant respectfully submits that independent Claim 1, which has been rejected under 35 U.S.C. § 103 (a) is patentable over the cited '365 Cookson and '761 Rodriguez patents.

In addition, the dependent Claims that depend from Claims 1, specifically Claims 2-5 add further limitations to the independent claims and, as such, as a matter of law, if the independent claims are found patentable so too should the accompanying dependent claims.

The '761 Rodriguez Patent Does Not Teach or Suggest Damaging or Deteriorating a Digital Music File

The '761 Rodriguez patent teaches that use of an audio watermark on a business card. The audio watermark may include data fields that specify technical playback. As stated at Column 45, lines 29-35, these parameters can invoke special-effects, such as echo effects, reverb etc. These special-effects are brought on for the benefit of the audio watermark and are not intended to deteriorate or damage the digital music file. As stated they are "special-effects" that a user inserts to create a certain desirable sound effect in the musical file.

Claims 1 and 6 of the present invention specifically state that the music file must be either deteriorated or damaged in sound quality. The damaging or deteriorating of the music file results in an advertising music file, which is less in quality than a marketable music file.

For this reason, applicant respectfully submits that independent Claims 1 and 6, which have been rejected under 35 U.S.C. § 103 (a) are patentable over the cited '365 Cookson and '761 Rodriguez patents.

In addition, the dependent Claims that depend from Claims 1, specifically Claims 2-5 add further limitations to the independent claims and, as such, as a matter of law, if the independent claims are found patentable so too should the accompanying dependent claims.

The '365 Cookson Patent and the '761 Rodriguez Patent Provide No Teaching or Suggestion of the Methods for Damaging and Deteriorating Music Files as Claimed by Dependent Claims 2-5 and Claims 7-10

As stated by the Examiner, (page 6, 3rd paragraph and page 8, 5th paragraph of the 27 January 2004 Office Action) Cookson "lacks explicit teaching of the "voice", "sampling rate, "distorting the waveform" and "multi" to "single-channel" limitations of claims 2-5" and Cookson "lacks explicit teaching of the "voice", "sampling rate, "distorting the waveform" and "multi" to "single-channel" limitations of claims 7-10 "

Similarly, the '761 Rodriguez patent provides no teaching or suggestion of the further limitations claimed in dependent claims 2 -5 and claims 7-10. Specifically, the '761 Rodriguez patent provides no teaching of inserting a noise component such as a voice in the original/collected music file (claims 2 and 7), lowering the sampling rate of the original/collected music file (claims 3 and 8), distorting the waveform of the original/collected music file (claims 4 and 9) or converting multi-channel sound of the original/collected file to a single-channel sound (claims 5 and 10). The Examiner provides no insight into where these teachings can be found in the '761 Rodriguez patent. The Examiner relies on the combination of the disclosure of Rodriguez with the teachings of Cookson to *derive* the elements and limitations of claims 2-5 and claims 7-10. The applicant is unclear as to how the combined references can be used to derive the elements of claims 2-5 and claims 7-10. The applicant is further unclear as to how obviousness under 35 U.S.C. § 103 (a) can be applied without a clear showing of all of the claimed limitations.

For this reason, applicant respectfully submits that dependent Claims 2-5 and 7-10, which have been rejected under 35 U.S.C. § 103 (a) are patentable over the cited '365 Cookson and '761 Rodriguez patents.

The '365 Cookson Patent and the '761 Rodriguez Patent Do Not Teach or Suggest Collecting an Illegally Produced Digital Music File, Editing the Collected File and Distributing the Collected File through the Computer Communication Network

As noted above, the '365 Cookson patent teaches a method for inserting two watermarks in a digital music file; a robust mark that represents the permissible use to be made of the music and a weak watermark that is destroyed if the music is compresses and then examining the file to

determine the presence of the marks in order to determine the allowed use of the music. As such, the '365 Cookson patent provides producing fully functional and, in fact, "marketable" digital music files. The '365 Cookson patent provides no teaching of collecting illegal music files, editing the collected illegal file, and distributing the edited file on the computer communication network.

In a similar regard, the '761 Rodriguez patent teaches watermarked business cards that may contain audio watermarks having technical playback parameters. As such, the '761 Rodriguez patent provides no teaching of collecting illegal music files, editing the collected illegal file, and distributing the edited file on the computer communication network.

Claim 6 of invention specifically claims the steps of collecting illegal music files, editing the collected illegal file, and distributing the edited file on the computer communication network.

For this reason, applicant respectfully submits that independent Claim 6, which has been rejected under 35 U.S.C. § 103 (a) is patentable over the cited '365 Cookson and '761 Rodriguez patents.

In addition, the dependent Claims that depend from Claims 6, specifically Claims 7-10 add further limitations to the independent claims and, as such, as a matter of law, if the independent claims are found patentable so too should the accompanying dependent claims.

Conclusion

In view of the proposed amended claims and the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office at Fax No. (703) 872-9306 on the date shown below.

James C. Edwards
CLT01/4654777v1

June 28, 2004
Date